

REMARKS

By the above amendment, independent claim 2 has been amended to clarify features thereof and claims 7 and 14 have been amended to utilize "when" instead of "if"..

The rejection of claims 2 - 3, 5 - 8, 10, 12 - 15, 17, 19 - 23 and 26 - 29 under 35 USC 103(a) as being unpatentable over Yablonowski et al in view of Kitamura et al (US 5,762,265), is traversed insofar as it is applicable to the present claims, and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be

remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Before discussing the inapplicability of the cited art to the claimed invention, applicants note that throughout the office action, the Examiner fails to given proper consideration to functional claim limitations and contends that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function citing In re Danley which is a 1959 decision of the CCPA. Reference is made to MPEP §2173.05(g) entitled "Functional Limitations" which points out and cites decisions subsequent to the 1959 Danley decision, that there is nothing inherently wrong with defining some part of an invention in functional terms and that a functional limitation must be evaluated and considered, just like any other limitation to the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art and the context in which it is used. As indicated, a functional limitation is often used in association with an element, ingredient, or step of the process to define a particular capability or purpose that is served by the recited element, ingredient or step. As such, applicants submit that the Examiner cannot disregard functional

limitations in apparatus or method claims as is apparent from the more recent decisional law and the guide lines or policy of the US Patent and Trademark Office as represented by MPEP §2173.05(g).

In applying Yablonowski, the Examiner recognizes that "Yablonowski does not explicitly teach that said data related to air conditioning includes data regarding temperature and humidity of atmosphere". Applicants note that Yablonowski is directed to determining the power consumption of a lighting system, which power consumption may be affected by whether or not air conditioning is provided. However, Yablonowski et al provides no disclosure or teaching that the power consumption of the lighting system varies in accordance with temperature and humidity data of the lighting space. Rather, Yablonowski et al merely teaches that power consumption of a lighting system will be reduced by installing a low calorific value lighting system and an energy saving may be utilized to determine a fee to be charged to the end user, which fee is a function of the difference between original power consumption of the old lighting system and the new power consumption of the new lighting system. In any event, Yablonowski et al provides no disclosure or teaching of the features of claim 2 and the other independent and dependent claims of this application in which a database which stores past data about energy consumption of a production facility and/or a utility facility utilizing cold or warm heat energy before taking energy-saving measures includes the feature of storing the past data in a form correlated with data of temperature and humidity of atmosphere, the feature of measuring present data of the energy consumption of the facility after taking the energy saving measures together with temperature and humidity data, the feature of calculating by retrieving the past data having temperature and humidity data within a set allowable range corresponding to the measured present data

having the temperature and humidity data, and the feature of calculating the energy curtailment quantities by comparing the retrieved past data having temperature and humidity data and the measured present data having the temperature and humidity data. Thus, applicants submit that all claims patentably distinguish over Yablonowski et al in the sense of 35 USC 103 and should be considered allowable thereover.

The Examiner recognizing the deficiencies of Yablonowski et al that it would be obvious to combine Yablonowski et al with Kitamura et al.

Turning to Kitamura et al, irrespective of whether or not Kitamura et al teaches a system for monitoring conditions of an air conditioning unit for cooling a space which conditions include detected humidity, air flow velocity, radiation temperature and the amount of clothing and amount of activity in such space, such is utilized to calculate a setting room temperature, as described in column 13, lines 26 - 31 of Kitamura et al. Moreover, the invention of Kitamura as described in column 1, lines 5 - 11 under the heading "Field Of The Invention" relates to an air conditioning control unit provided with a function of calculating an optimal room temperature setting value in accordance with the thermal feeling votes of inhabitants. Thus, as described in the "Abstract" of Kitamura, there is provided a data storage unit for storing for complaint rates together with indoor thermal conditions, updating means for calculating a function representing the relationship between thermal conditions and complaint rates in accordance with stored data and predicted thermal conditions calculating means for calculating thermal setting values by substituting entered control information into the function representing the relationship between thermal conditions and complaint rates. While the Examiner contends that Kitamura teaches "means for calculating of savings in energy consumption based on said stored data"

referring to column 13, lines 47 - 56 of Kitamura et al, applicants submit that this position by the Examiner is a mischaracterization of the disclosure of Kitamura et al, noting that column 19, lines 66 to column 20, line 7 of Kitamura et al, which is referred to by the Examiner merely points out that when the air conditioning is controlled in consideration of the complaint rate, reasonable energy-saving operation can be accomplished. However, Kitamura et al fails to disclose or teach the taking of energy-saving measures by installing energy-saving equipment and calculating means for retrieving past data having temperature and humidity data within a set allowable range corresponding the measured present data having the temperature and humidity data or the facility and calculating the energy curtailment quantities by comparing the retrieved past data having temperature and humidity data and the measured present data having the temperature and humidity data, as recited in independent claim 2 and generally recited in the other independent and dependent claims of this application. Thus, contrary to the contentions by the Examiner, Kitamura et al does not overcome the deficiencies of Yablonowski et al, and the suggested combination fails to provide the claimed features as set forth in the independent and dependent claims of this application in the sense of 35 USC 103.

With respect to the features of the dependent claims, as pointed out above, the Examiner cannot ignore the recited features as lacking structural limitations and therefore given no patentable weight which is contrary to MPEP §2173.05(g). Additionally, contrary to the Examiner's contention that the recited features represent intended use, which may be derived from the utilization of the term "if" by the present amendment, claim 7 has been amended to utilize "when" rather than "if" and applicants submit that such features must be given patentable consideration.

Applicants note that claim 14 has been amended in a similar manner. Thus, claims 7 and 14 also patentably distinguish over the cited art in the sense of 35 USC 103.

As to the other independent and dependent claims, applicants submit that the combination of Yablonowski et al and Kitamura et al fail to disclose the claimed features as set forth therein in the sense of 35 USC 103 for the reasons given above, and all claims patentable distinguish over the cited art and should be considered allowable at this time.

In view of the above amendments and remarks, applicant submit that all claims should now be considered to patentable distinguish over the cited art and an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 389.40083X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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